

REMARKS / ARGUMENTS

This amendment is submitted in full response to the outstanding Office Action dated November 17, 2004 wherein the Examiner has rejected claims 1-3, 16-20, 26 and 28 under 35 U.S.C. 102(b) as being anticipated by Grenga et al. (U.S. Patent No. 4, 291,738). However, the Examiner clearly indicates on page 2 of the outstanding office action that claims 4-15, 21-25 and 27 stand objected to only as being dependent upon a rejected base claim. Further, these claims are indicated as being allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

ALLOWABLE CLAIMS

Based on the acknowledgment by the Examiner of allowable subject matter, amendments to the claim program as indicated above, include an amendment of independent claim 1 to include the allowable recitation of claim 5. In addition, new independent claim 29 is submitted herewith and comprises the original recitation of independent claim 1 plus the allowable recitation of claim 6. Similarly, newly submitted independent claim 30 comprises the original recitation of independent claim 19 plus the allowable recitation of claim 21 and intervening

claim 20. Finally, newly submitted independent claim 31 comprises the original recitation of claim 19 plus the allowable recitation of dependent claim 27. Based on the Examiner's indication of allowable subject matter in claims 6, 21 and 27, Applicant now respectfully contends that amended independent claim 1 and newly submitted independent claims 29, 30 and 31 all contain allowable subject matter.

OUTSTANDING REJECTIONS UNDER 35 USC 102

Before reviewing the substantive issues with regard to the rejection of the claims under 35 U.S.C. §102, the Applicant respectfully points out the well established requirement that:

For a prior art reference to anticipate in terms of 35 U.S.C. §102, **every** element of the claimed invention must be **identically** shown in a single reference. Diversitech Corp. v. Century Steps, Inc., 7 USPQ2d 1315, 1317 (Fed. Cir. 1988) (emphasis added).

Moreover, this burden on the U.S. Patent and Trademark Office is further compounded by the fact that the Federal Circuit has stated that within the single reference:

[t]he identical invention must be shown in as complete detail as is contained in the patent claim. Richardson v. Suzuki Motor Co. Ltd., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

And, more recently, the Federal Circuit has further expanded this principle to include:

. An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed in the prior art and that such existence would be recognized by persons of ordinary skill in the field of the invention. Crown Operations Int'l, Ltd. v. Solutia Inc., 289 F.3d 1367, 62 USPQ2d 1917, 1921 (Fed. Cir. 2002).

As such, if an Applicant can establish that at least one claimed element is not present or is not identically disclosed in complete detail in the prior art reference put forth by the PTO, the grounds for rejection pursuant to 35 U.S.C. §102 of each claim comprising that element have been overcome. Furthermore, once the grounds for rejection under 35 U.S.C. §102 have been overcome, the PTO can not merely turn to 35 U.S.C. §103 as a basis for maintaining a rejection without first meeting the requisite burden. Specifically, the decisions of the Federal Circuit instruct that:

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art [and further that] the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

Recently, this point was further emphasized by the Federal Circuit, which added that:

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the [Examiner] to show a motivation to combine the references that create the case of obviousness. In other words, the [Examiner] must show reasons that the skilled artisan, confronted with the same problems as the inventor (**and with no knowledge of the claimed invention**), would select the elements from the cited prior art references for combination in the manner claimed. (emphasis added).

This court has identified three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. Beckson Marine, Inc. v. NFM, Inc., 292 F.3d 718, 63 USPQ2d 1031, 1037 (Fed. Cir. 2002); citing In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

With appreciation for the Examiner's detailed review of the subject application and the claim program associated therewith, the Examiner is respectfully requested to reconsider her position regarding independent claim 19, as now amended. This claim defines at least one preferred embodiment of Applicant's invention which is directed to an assembly to retain a louver in operative orientation, wherein the assembly includes a support plate secured to an upper end of the louver and including a stabilizing structure mounted adjacent a connecting portion of the carrier assembly and cooperatively disposed to restrict relative, lateral displacement of the support plate and the connecting portion. In addition, amended independent claim 9

specifically recites a one piece retaining clip having an open interior and an interior surface disposed in at least partially surrounding, clamping engagement with the connecting portion and further wherein said interior surface includes a recessed configuration disposed in retaining relation to the connecting portion.

A review of the Grenga et al. patent in light of the Examiner's interpretation thereof, as set forth in detail on page 2 of the outstanding Office Action, discloses a plate 68, which the Examiner refers to as a clip in supporting the rejection of claims 1 through 3 and 16 through 18. Further, the Examiner interprets Grenga et al. as including a stabilizing structure, holes 68 (70, 72, 74?) and the surface 68 (?) as well as clip 45. Applicant respectfully suggests that Grenga et al, as specifically applied by the Examiner, does not comply with the requirements for maintaining an anticipatory rejection under 35 U.S.C. 102. As emphasized continuously in the above-cited cases, every element of Applicant's claimed invention must be identically shown in a single reference in as complete detail as is contained in the claim language of the patent application in question. Further, an anticipating reference must describe the

claimed invention with sufficient clarity and detail to establish that the subject matter existed in the prior art to the extent of being recognized by a skilled artisan.

Therefore, Applicant contends that the recitation of amended claim 19 defines specific structural features of Applicant's invention which are not identically disclosed or even suggested by the Grenga et al. patent. The distinguishing claim language of amended claim 19 includes, but is not necessarily limited to, a one piece retaining clip including an open interior and an interior surface, wherein the interior surface is disposed in at least partially surrounding relation and in clamping engagement with the connecting portion. Clearly Grenga et al. does not show a one piece clip having an open interior and an interior surface which is disposed in surrounding, clamping engagement with the connecting portion of the carrier assembly. Accordingly, Applicant believes that claim 19, as amended, recites allowable subject matter over the primary reference of record to Grenga et al. as well as the remaining references of record, whether considered either singularly or in combination.

CONCLUSION

Based on the above amendments and remarks reconsideration of this application is hereby requested. It is believed that this application is now in condition for allowance and such action is respectfully requested.

In addition, an appropriate request for an extension of time is enclosed herewith along with the corresponding PTO fee. In the event that any additional fee may be required by the filing of this paper, the Commissioner is hereby authorized to charge any fees and/or credits to our **Deposit Account No. 13-1227**.

Respectfully Submitted,

MALLOY & MALLOY, P.A.
Attorneys for Applicant
2800 S.W. 3rd Avenue
Historic Coral Way
Miami, Florida 33129
(305) 858-8000

By: 

Peter A. Matos
Reg. No. 37,884

Date: 3/17/05

Application No. 10/643,807

Amdt. dated March 17, 2005

Reply to Office Action dated November 17, 2004

F:\MM DOCS\1-PAT\PAT 2003\APP\1252-03 Sans Folch\1252 Amendment-1.doc

Amendments to the Drawings:

Included with this application are two replacement sheets including Figures 1, 2 and Figures 16-21 respectively, which are to be substituted for the two sheets of annotated drawings comprising these same figures as originally filed and now amended.

Attachment: Two Replacement Sheets
 Two Annotated Sheets Showing Changes



APPENDIX

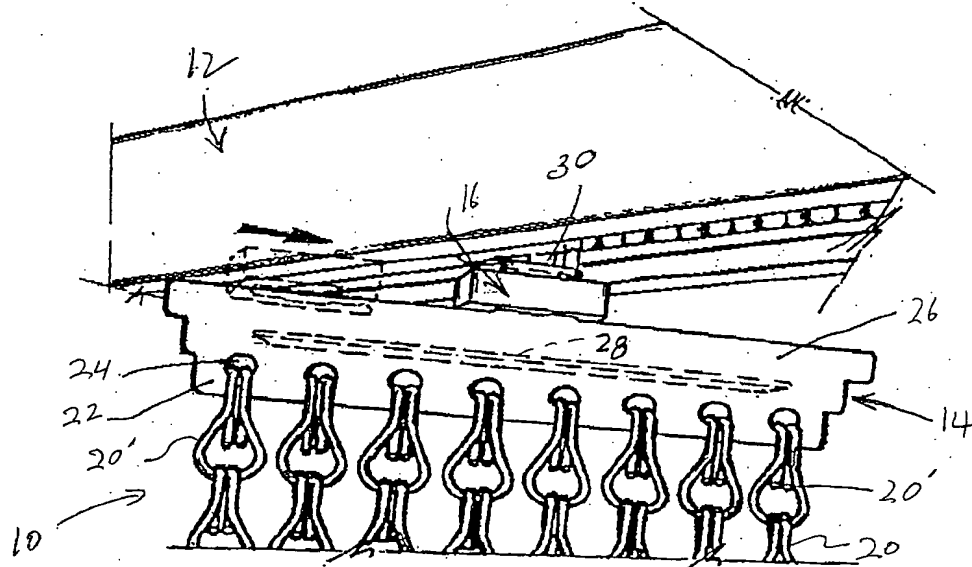


FIG 1

*Add reference
 numerals to Fig 2*

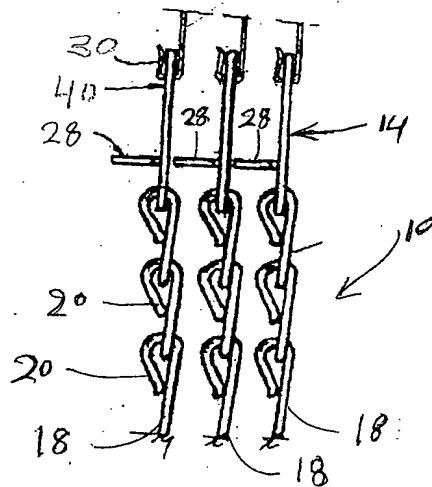


FIG 2

Remove lead lines
from FIG 16

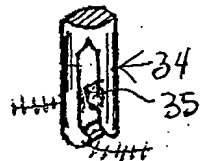


FIG. 16

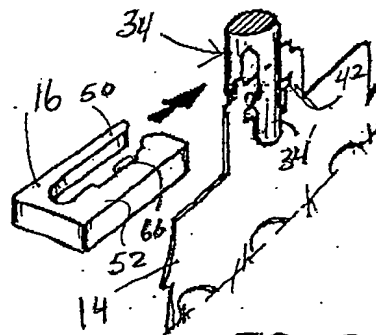


FIG. 17

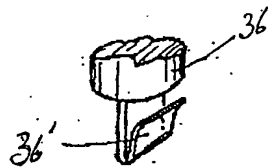


FIG. 18

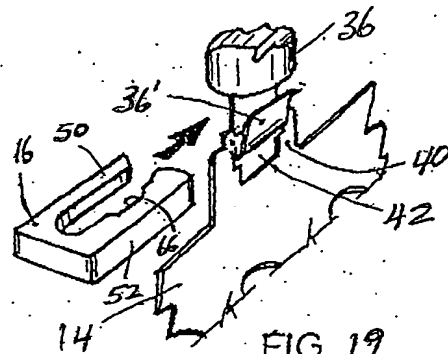


FIG. 19

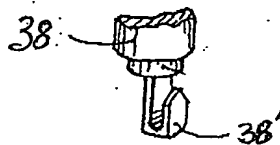


FIG. 20

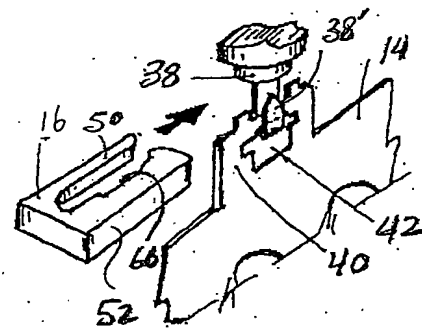


FIG. 21

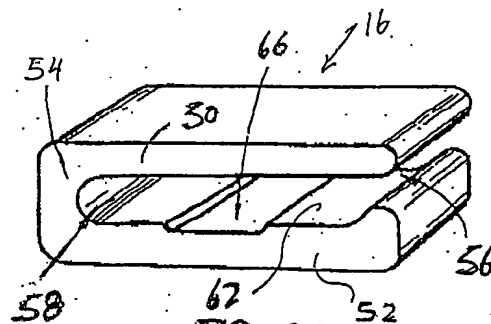


FIG. 22